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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/585,129      | 05/31/2000  | Scott T. Hughes      | K35A0614            | 3846             |

26332 7590 03/28/2003

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LAKE FOREST, CA 92630

EXAMINER

BACKER, FIRMIN

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3621

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/585,129

Applicant(s)

HUGHES ET AL.

Examiner

Firmin Backer

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Request for Reconsideration***

This is in response to a request for reconsideration file February 21<sup>st</sup>, 2003. Claims 1-10 are being reconsidered in this action.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al (U.S. PA Pub. No. 2002/0072965 A1) in view of Cottingham (U.S. Patent No. 6,339,761).
4. As per claim 1, Merriman et al teach a method of operating a content delivery system for distributing advertising content (*methods and apparatuses for delivery of advertisements*) to users of personal computers (*users' browser, 16*), (*see fig 1, 2*) comprising collecting (*gathers*) identification data (*information about individual users*) from a network (*network 10*) of personal

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computers, receiving the advertising content from an advertiser (*see page 2 paragraph 0026*), formatting the advertising content for storage and display in the personal computers (*see page 3 paragraph 0021*), and distributing, using the collected identification data, the formatted advertising content to the personal computers (*see page 2 paragraph 0017, 0018, 0021*).

Merriman et al fail to teach an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment. However, Cottingham teaches an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (*see column 23 lines 35-43, 7 lines 50-58*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Merriman et al's inventive concept to include Cottingham's personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment because this would have allowed advertiser to track consumer response to specific elements of the Web page/application environment as well as to better infer information about the user's interests in an effort to qualify the user prior to presenting subsequent advertising.

5. As per claims 2, 3, Merriman et al teach a method wherein the identification data comprises a unique identifier/internet protocol that is associated with one of the personal computers (*see page 2 paragraph 0018*).

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6. As per claim 4, Merriman et al teach a method of receiving preference data from the personal computers; and selecting the advertisement data that is to be distributed, at least in part, based upon the received preferences (*see page 2 paragraph 0017, 0018, 0021*).

7. As per claim 5, Merriman et al teach a method of associating a fee with data representative of the advertiser, and storing the fee in a storage device (*see page 3 paragraph 0021*).

8. As per claim 6, Merriman et al teach a content delivery system comprising for distributing advertising data (*methods and apparatuses for delivery of advertisements*) to a network of personal computers (*users' browser, 16*), (*see fig 1, 2*) comprising an identification database comprising identification data, wherein the identification data uniquely identifies a computer or a user in the network of personal computers (*information about individual users*) (*see page 2 paragraph 0017, 0018, 0021*), an advertisement database comprising advertising data (*advertising server processes, 19*), a collection module for collecting the identification from the network of personal computers and storing the collection information in the identification database (*see page 2 paragraph 0017, 0018, 0021*), a formatting module for formatting and storing advertisement data in the advertisement database (*see page 3 paragraph 026*), and a control module that distributes the formatted advertising data to the network of personal computers upon the occurrence of one or more events (*see page 2 paragraph 0017, 0018, 0021*). Merriman et al fail to teach an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or

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before bootloading a user selected application environment. However, Cottingham teaches an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (*see column 23 lines 35-43, 7 lines 50-58*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Merriman et al's inventive concept to include Cottingham's personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment because this would have allowed advertiser to track consumer response to specific elements of the Web page/application environment as well as to better infer information about the user's interests in an effort to qualify the user prior to presenting subsequent advertising.

9. As per claims 7, 8, Merriman et al teach a content delivery system wherein the identification data comprises a unique identifier/internet protocol that is associated with one of the personal computers (*see page 2 paragraph 0018*).

10. As per claim 9, Merriman et al teach a content delivery system wherein the control module receives preference data from the personal computers, and wherein the control module selects the advertisement data that is to be distributed, at least in part, based upon the received preferences (*see page 2 paragraph 0017, 0018, 0021*).

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11. As per claim 10, Merriman et al teach a content delivery system wherein the control module associates a fee with data representative of the advertiser; and wherein the control modules stores the fee in a storage device that is associated with one of the personal computers (*see page 2 paragraph 0026*).

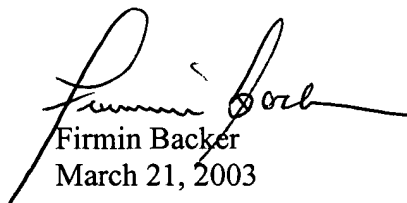
### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (*see PTO 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Firmin Backer  
March 21, 2003